REMARKS

Claims 19-50 and 54-56 have previously been canceled, without prejudice. Original claims 1-18 and 51-53 remain in the application.

Claims 1-18 and 51-53 have been provisionally rejected for obviousness-type double patenting over US Patent Application No. 09/679,039. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

Claims 1-18 and 51-53 are rejected for obviousness over US Patent No. 5,848,397 ("Marsh"). That rejection is respectfully traversed for the following reasons.

Claim 1, which is representative of the rejected claims, is directed to software for use on a client device that is configured for communications with at least one remote source of advertisements via a communications network. The software includes an advertisement download function that downloads advertisements from the at least one remote source, during one or more advertisement download sessions, an advertisement storage function that stores the downloaded advertisements on a storage medium associated with the client device, and an advertisement display function that effects display of at least selected ones of the stored advertisements on a display associated with the client device. Claim 1, and all of the rejected claims, further comprehend:

"an obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement currently being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display; and

an obscured ad nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured ad nag display notifies the user of the obscured ad condition."

The only prior art cited in the Office Action is Marsh, and the assertion is that, since Marsh teaches monitoring and displaying various showcase ads which can occupy the entire portion of the display, along with banner advertisements, "then it would have been obvious to a person of ordinary skill in the art at the time of the Applicants' invention to have included" the detection of ad obscuration and notice to the user "in

order for the user to be aware that it might not be compensated for viewing the banner advertisements that is being obscured by the Showcase advertisement."

As implicitly conceded in the Office Action, at the time the invention was made, the prior art did not teach a client device software with advertisement download, storage, and display functions that includes "an obscured ad monitor function" and "an obscured ad nag function". See MPEP 2141.01 III. In fact, the only way which such an invention could be appreciated during examination is with reference to the applicants' specification. However, such hindsight reasoning is expressly forbidden. See *In re Dembiczak*, 50 USPQ2d at 1617, (Fed. Cir. 1999).

The only support given for the proposed modification of Marsh by addition of the obscured ad detection and nag functions is the assertion that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made" because Marsh teaches monitoring and displaying showcase ads that might obscure banner ads. In fact, Marsh teaches monitoring, displaying, and scheduling ad display, the latter function being provided, in part, to control the display "of both the banner advertisements 600 and the showcase advertisements 1001." See Marsh at column 8, lines 35-40. This function maintains prioritized queues of ads, stepping through the current queue and displaying ads according to a priority order "until all of the advertisements" in the queue have been shown. The next queue is then accessed, and so on. See Marsh at column 9, lines 7-19. In order to ensure that a user actually views the ads, the scheduler function monitors user activity and times out when there is no such activity. Marsh does not teach that one ad may obscure another ad; indeed, the teaching is that "all" of the advertisements are shown.

In contrast, a problem addressed by the rejected claims is obscured or hidden ads as exemplified by "the relative ease with which a user might be able to hide the ads from view by placing a small window directly over the ad. " See the specification at page 29, lines 10-12. In the invention of the rejected claims this problem is solved by the claimed software which "performs a check to determine that the ad is both onscreen and uncovered. If the screen state does not satisfy both of these criteria, the software will either nag the user to uncover the ad or automatically re-order the windows so that the ad is uncovered." See the specification at page 29, lines 12-16. This solution is implemented in the obscured ad detection and nag functions that are explicitly recited in claim 1, and that limit all of the rejected claims.

not claimed

Marsh does not teach or suggest any action at all that hides ads; banner and showcase ads are scheduled to ensure that all ads are displayed, and ad display is timed out when user activity ceases. Marsh's message presentation apparatus simply doesn't have any need to detect hiding an ad and nagging to notify a user of such hiding.

Accordingly, there was no suggestion at the time the invention was made to modify Marsh by adding "an obscured ad monitor function" and "an obscured ad nag function". The applicants therefore request the citation of a reference or entry of an affidavit to support the assertion that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made" to so modify Marsh, otherwise, this rejection should be withdrawn. See MPEP 2144.03.

Further, since Marsh has no teaching or suggestion of a "hidden ad" problem, there is no motivation or suggestion to modify it to include the obscured ad detection and nag functions. Marsh does not explicitly teach the obscured ad detection and nag functions; and, without a reference or an affidavit, there is no basis for asserting that those functions are suggested, by Marsh or any other reference of record. Accordingly, no *prima facie* case of obviousness has been established. See MPEP 2143 *et seq.*

With respect to claims 4 and 5, Official Notice is taken that "it is old and well known in the computer related arts to switch from one operating mode to another operating mode that has less features when a problem arises with one of the operating modes" in order to minimize problems that might otherwise occur. See the Office Action at page 4, second full paragraph, lines 1-7. Perhaps this is so when software problems occur; however, neither claim 4 nor claim 5 is directed to software problems. Instead, each claim is directed to further characterization of an obscured ad nag function in providing options to the user, not to software. It is respectfully submitted that such limitations of this function, which is not known in the art, are not and cannot be of such notorious character as to merit Official Notice. Accordingly, the applicants respectfully request citation of a reference or entry of an affidavit to support this statement. See MPEP 2144.03.

Therefore, in view of the failure of the art of record in this application to teach or suggest the entire invention recited in claims 1-18 and 51-53, it is submitted that these claims recite subject matter that is both novel and unobvious.

A Petition to Extend Time and the appropriate fee for the extension are submitted herewith to extend the response period for the Requirement by one month, from December 15, 2003 to January 15, 2004. The Commissioner is authorized to charge payment of any fees that may be required, or credit any overpayment, to Deposit Account No. 17-0026. A duplicate of this paper is submitted.

Respectfully submitted,

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